

## **REMARKS**

New claims 37-43 are the only active claims pending in this application. Claims 1-6 are canceled. Claims 7-36 are withdrawn. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, each with an indication at its first line showing the claim's current status.

### **I. Request for Acknowledgement of Foreign Priority**

This application was filed with a claim of foreign priority under 35 U.S.C. §119(a)–(d) based on the following Japanese Patent Applications: 2002-334236 filed November 18, 2002; 2002-334238 filed November 18, 2002; 2002-334240 filed November 18, 2002; and 2003-068370 filed March 13, 2003. Certified copies of the priority documents were filed on January 30, 2006. Acknowledgment of the claim of foreign priority and acknowledgment of receipt of the priority documents is again respectfully requested.

### **II. Rejections Based on Prior Art**

Claims 1-6, now canceled, were rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent Application No. EP 1 407 893 A2 ("Janosky") in view of U.S. Patent No. 6,332,679 ("Higuma"). Applicants traverse the rejection, on the grounds that the combined teachings of Janosky and Higuma lack elements of Applicants' claim 1, and lack the required teaching or suggestion for combining and modifying their respective disclosures toward Applicants' claim 1.

For purposes of expediting the instant application, Applicants have canceled claims 1-6, without prejudice or disclaimer, and submit new method claims 37-43 that are drawn to methods disclosed by Applicants' original specification, claims and drawings.

Applicants respectfully submit that new claim 37 is patentable over the collected teachings of Janosky and Higuma, as these lack elements of claim 37, and lack a teaching, suggestion or other showing of any motivation by which one

layer 20, with a distal heater 25, and then embossing a surface quality on the exposed surface of that protective layer 20.

Janosky discloses nothing of a thermoplastic layer disposed on a base with an image recording layer disposed on the thermoplastic layer.

Janosky discloses nothing of heating a layered structure as recited by Applicants' claim 37, explicitly or inherently. All that Janosky's apparatus must inherently do, in terms of heating, to operate as Janosky describes, is to heat the protective layer 20 to a depth sufficient to receive a surface quality impressed on it.

Janosky discloses nothing of transferring a surface quality to an interface between a thermoplastic layer and an image recording layer. What Janosky discloses is transferring a surface quality to the upper exposed surface of a protective layer that is disposed on top of an image recording layer. That is all that Janosky teaches or discloses regarding transferring surface quality.

The secondary reference, Higuma, does not disclose structure within the broadest reasonable meaning of the claim 37 "thermoplastic layer." Higuma discloses a porous transfer layer, having thermoplastic particles in suspension, functioning to transfer ink to the underlying image recording layer. The porous layer is flattened as part of the image transfer process.

Applicants respectfully submit that Higuma's sponge-like porous matrix of thermoplastic particles is not within the broadest reasonable meaning of the claim 37 "thermoplastic layer."

Applicants also respectfully submit that forming a porous transfer layer on top of the image recording layer is integral and necessary to Higuma's method; if the transfer layer was not porous or not formed on top of the image layer Higuma's method would not operate.

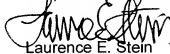
Claims 38-43 are dependent on claim 37 and, therefore, are patentable over the combination of Janosky and Higuma for at least the reasons presented for claim 37.

Applicants respectfully request, for the foregoing reasons, that the application be reconsidered, that at least claims 37-43 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is respectfully requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Laurence E. Stein".

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